

Serial No. 10/070,758

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2, 12 to 14 and 18 to 21, of the application. No new matter has been added.

The Examiner rejected Claims 1 to 9 and 12 under 35 U.S.C. §102(b) as being anticipated by, and further under 35 U.S.C. §103(a) as being unpatentable in light of, the teaching of Denzinger et al. (US 4,402,937).

With regard to the Examiner's assertion that the reference anticipates applicants' invention within the meaning of Section 102, it is respectfully noted that the Examiner conceded that the teaching fails to exemplify the relationship between the concentration c and the Fikentscher K value of the polyvinylpyrrolidone which is required in accordance with applicants' claims.<sup>2)</sup> In fact, Denzinger et al.'s teaching merely generically provides that the polyvinylpyrrolidone may have a Fikentscher K value from 8 to 50 and a concentration in the range of from 10 to 60% by weight, with the higher concentrations applying to polymers of low K value, and vice versa.<sup>3)</sup> As applicants have repeatedly pointed out, anticipation under Section 102 can only be found if a reference shows exactly what is claimed, i.e. the identical subject matter has to be shown in the reference in as complete detail as is contained in the claim.<sup>4)</sup> It has also already been emphasized by applicants that a generic disclosure is not sufficient to anticipate each species or subgenus which happens to fall within the generic range of the disclosure.<sup>5)</sup> Since the Examiner conceded that the reference failed to provide an exact description of applicants' invention as is necessary for a finding of anticipation under Section 102, the Examiner's rejection under this Section is clearly in error. It is therefore again respectfully urged that the rejection be withdrawn. Favorable action is solicited.<sup>6)</sup>

2) Cf. page 4, line 3, of the Office action.

3) Cf. col. 3, indicated lines 37 to 41, and col. 4, indicated lines 33 to 37, of US 4,402,937.

4) Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989); Lindemann Maschinenfabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

5) Note in particular Corning Glass Works v. Sumitomo Electric U.S.A., 868 F.2d 1251, 9 USPQ2d 1962 (Fed. Cir. 1989), and Minnesota Mining & Manufacturing Co. v. Joplinson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992), which emphasize that a genus does not inherently disclose all species; and also In re Jones, 958 F.3d 347, 21 USPQ2d 1614 (Fed. Cir. 1992), and In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994), which point out that a genus does not even render all species that happen to fall within the genus obvious.

6) The respective comments put forth by applicants in the papers dated October 21, 2003, April 20, 2004, and August 12, 2004, are herewith incorporated by reference.

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In the context of the rejection of applicants' claims under Section 103(a) the Examiner asserted that a person of ordinary skill in the art would have been motivated to optimize the starting concentration of the polyvinylpyrrolidone by routine experimentation in order to improve the stability of the product. However, a particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.<sup>7)</sup> No such recognition is found or even suggested by the teaching of Denzinger et al. To the contrary, according to the reference the increased stability is a result of balancing the iodine:iodide ratio and the partition coefficient, and of carrying out the reaction of polyvinylpyrrolidone and iodine in the presence of certain acids.<sup>8)</sup> The Examiner's position that it was *prima facie* obvious from the teaching of Denzinger et al. to optimize the concentration of the polyvinylpyrrolidone is, therefore, deemed to be in error.

Moreover, applicants present herewith as Declaration of Dr. Dobrawa which sets forth technical information on the behavior of the reaction between polyvinylpyrrolidone and iodine when the concentration of the polyvinylpyrrolidone and/or the Fikentscher K value thereof is modified. The Declaration is deemed to be self explanatory and the data contained therein clearly demonstrate the significant impact of the K value and the minimum concentration of the polyvinylpyrrolidone on the ease of reaction (ie. the reaction time and the suppression of sedimentation and sublimation), as well as on the quality of the product (ie. the amount of available iodine and the iodine loss). Particularly noteworthy are, however, the surprising results of examples 1 and 2 and comparative example 1. Although, the concentration of the polyvinylpyrrolidone-solution is higher in examples 1 and 2 than in comparative 1 and thus the viscosity of the solution at the onset of the reaction is higher for examples 1 and 2 than for comparative example 1, bad mixing occurs only in comparative example 1. This result is clearly contrary to what a person of ordi-

7) Cf. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977) (The claimed wastewater treatment device had a tank volume to contractor area of 0.12 gal./sq. ft. The prior art did not recognize that treatment capacity is a function of the tank volume to contractor ratio, and therefore the parameter optimized was not recognized in the art to be a result-effective variable.).

8) Cf. in particular col. 2, indicated line 63, to col. 3, indicated line 2, of US 4,402,937.

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nary skill in the art would reasonably have expected. Correspondingly, the reaction mixture encountered in example 3 should have a higher viscosity than the reaction mixture of comparative example 2. However, sedimentation occurs only in comparative example 2.

The Examiner's position that the subject matter of applicants' claims was obvious under Section 103(a) is, in light of the foregoing and the attached, not deemed to be well taken. It is respectfully requested that the rejection be withdrawn. Favorable action is solicited.

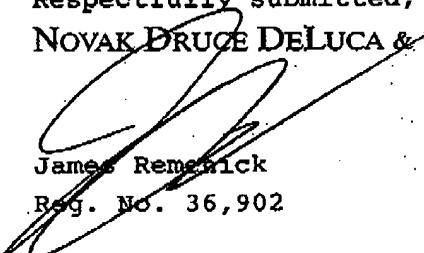
REQUEST FOR EXTENSION OF TIME:

It is respectfully requested that a two month extension of time be granted in this case. The respective \$450.00 fee is paid by credit card (Form PTO-2038 enclosed).

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,

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Encl.: CLAIM AMENDMENTS (Appendix I)  
Dr. Dobrawa's Declaration dated May 29, 2006

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